with the Examiner's request, which was refused on the ground that the requirements of 37 CFR 3.73 were not met.

Enclosed as Exhibit 1 is a copy of the assignments of the parent application, U. S. Patent 5,122,136, from the inventors to The Regents of the University of California as recorded at frame 5257, reel 0574, and frame 5257, reel 0577. Enclosed as Exhibit 2 is a copy of the assignments of the cip of U. S. Patent 5,122,136 from which this application directly continues from the inventors to their respective employers, namely The Regents of the University of California and Target Therapeutics respectively as recorded at frame 6030, reel 0823 for the former and as recorded at frame 6030, reel 0827, for the latter. Enclosed as Exhibit 3 is a copy of the assignment of the cip application from Target Therapeutics to The Regents of the University of California as recorded at frame 0359, reel 8919.

The evidentiary documents have been reviewed and assignee hereby certifies that to the best of assignee's knowledge and belief, title is in the assignee, namely The Regents of the University of California, who is seeking entry of the Terminal Disclaimer.

The holding of *In re Schneller*, 158 USSPQ 210 (CCPA 1968) does not prohibit granting of the present application subject to a terminal disclaimer. The terminal disclaimer having been submitted together with a showing under 37 CFR 3.73 of title, takes the present application out of the purview of the Court's ruling in that case.

The basis of rejection noted under 35 USC 112 has been responsively amended.

The rejection under 35 USC 103(a) is overcome by the terminal disclaimer.

Rejection Pursuant to 35 U.S.C. 102(e)

Claims 25 - 31 and 34 have been rejected under 35 USC 102(e) in view of the embodiment of Fig. 5 of **Ritchart et.al.**, *"Vaso-Occlusion Coil and Method,"* U.S. Patent 4,994,069 (1991).

Claim 25 is directed to a wire for use in the formation of an occlusion within a vascular cavity in conjunction with a microcatheter having an interior lumen. The wire comprises of metal coil. The metal coil has a first shape which conforms to the micro-catheter lumen when the metal coil is disposed within the microcatheter. The metal coil is biased to form a substantially undeformed cylindrical or single conical envelope when it is disposed out of the microcatheter. This is not to suggest that the environment of the coil's disposition does not in fact deform the coil to some other configuration due to exterior constraints, but only that there is no other biased configuration of the coil other than cylindrical or single conical envelope.

Ritchart discloses a coil wire for use in vaso-occlusion which when stretched has a linear condition in which it can be advanced through a catheter to a selected vessel. When **Ritchart's** wire is relaxed, a convoluted configuration is produced by a helically wound wire in which irregularities have been introduced in the winding. As set forth in the abstract of **Ritchart**, when the wire is released from the catheter, it assumes a randomly coiled, substantially spaced filling mass. The fabrication of the wires are described in connection with Figs. 2A - 2C. During this fabrication, wire 14 in Fig. 2A is formed into a helical winding 20 shown in Fig. 2B. The helical winding is illustrated as having a cylindrical envelope about an axis 23. However, the construction continues by pre-forming the wire " . . . to obtain irregularities in the helical winding, such that the wire adopts a folded, convoluted conformation in a relaxed condition, as illustrated in Fig. 2C." Column 5, lines 11-14. Fig. 2C shows and is described as

having a multiple lobed, clover shape. The remaining embodiments illustrated in **Ritchart** provide for even more random configurations of the coil when disposed outside of the catheter.

The use of the wire in the method of vaso-occlusion is described in **Ritchart** in connection with Figs. 8A-8D. Wire 14 is disposed in a linear configuration through catheter 12, as shown in Fig. 8A. Its shape within the catheter is a simple, straight wire without any envelope definition. As wire 14 is then extended from the end of catheter 12 into vessel 70, it assumes a random bird-nest shape as shown in Figs. 8b-8d, 9a-9c and 10. **Ritchart's** coil is neither a cylindrical nor conical envelope at any point in time, even while it is disposed within catheter 12 or when it is disposed outside of it.

Ritchart discloses a pusher coil which is generally taught as forming a "randomly coiled" mass when pushed out of the catheter. See Abstract, line 8; and col. 2, line 61 - col. 3, line 2. The coil has a generally cylindrical envelope which has been deformed by bends so that the resultant envelope is a randomly folded mass Fig. 3B.

The embodiment of Fig. 5 is stated at col. 6, lines 6 - 11, as being formed as in Fig. 3B, but with at least one helical turn equal to the vessel diameter. Literally, this would be a random mass with at least one helical turn equal to the vessel diameter. The "irregularities" in the helical winding are recited at col. 6, lines 11 - 15, as being a "continuous change in helical diameter" to form spirals to span the vessel diameter. Literally, this would be a random mass with "continuous change in helical diameter" of the deformed coil forming the random mass. Although the artist's illustration of Fig. 5B shows to opposing substantially conical envelopes, it is submitted that it is in not consistent with the teaching of the specification if it is to be read an contemplating an substantially unbiased conical envelope.

Moreover, in the amended claims a single unbiased regular conical envelope is claimed and not a double end-to-end configuration or a randomly biased mass with irregularities embedded in it. Therefore, it cannot be maintained that **Ritchart** anticipates each and every element of the invention as claimed.

The Examiner is respectfully requested to review the amended claims in light of the foregoing remarks and find that the claims are set forth in a condition suitable for allowance subject to the terminal disclaimer. Advancement of the claims' issuance is respectfully requested.

Respectfully submitted,

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